

ESTTA Tracking number: **ESTTA128871**

Filing date: **03/08/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|---|
| Name | California Tan, Inc. |
| Granted to Date of previous extension | 03/10/2007 |
| Address | 12777 W. Jefferson Blvd., 3rd Fl. Los Angeles, CA 90066 UNITED STATES |

| | |
|----------------------------|--|
| Correspondence information | California Tan, Inc. 12777 W. Jefferson Blvd., 3rd Fl. Los Angeles, CA 90066 UNITED STATES ccole@caltan.com Phone:310-824-2508 |
|----------------------------|--|

Applicant Information

| | | | |
|------------------------|---|------------------------|------------|
| Application No | 78880892 | Publication date | 01/09/2007 |
| Opposition Filing Date | 03/08/2007 | Opposition Period Ends | 03/10/2007 |
| Applicant | CHALLENGE PRODUCTS, LLC 748 BOLSANA DRIVE LAGUNA BEACH, CA 92651 UNITED STATES | | |

Goods/Services Affected by Opposition

| |
|---|
| Class 003. Opposed goods and services in the class: Skin care products, namely, beauty moisturizers, body moisturizers, cosmetic moisturizers, beauty gels, bath gels, shaving gels, shower gels, cosmetic gels, body gels, beauty oils, bath oils, body oils, shower oils, cosmetic oils, skin cleansers, and tanning lotions |
|---|

| | |
|-------------|--|
| Attachments | California Glow Opposition Statement.pdf (8 pages)(1400772 bytes) |
|-------------|--|

| | |
|-----------|----------------|
| Signature | /Christa Cole/ |
| Name | Christa Cole |
| Date | 03/08/2007 |

1. Challenge Products, LLC a California Limited Liability Company (“Applicant”) seeks to register “CALIFORNIA GLOW” (U.S. trademark application serial no. 78/880892) as a trademark for use in connection with Skin care products, namely, beauty moisturizers, body moisturizers, cosmetic moisturizers, beauty gels, bath gels, shaving gels, shower gels, cosmetic gels, body gels, beauty oils, bath oils, body oils, shower oils, cosmetic oils, skin cleansers, and tanning lotions as evidenced by the publication of said mark in the Official Gazette on January 9, 2007 (hereinafter the “Application”).

2. The Application was filed May 10, 2006 on the basis of Applicant’s intent to use. Applicant claims no earlier date for the purpose of claiming priority.

3. Opposer, itself and through its predecessor and related companies in interest (“Opposer”), has been engaged in the development, manufacture and sale of skin care products, namely tanning lotions, gels and oils, moisturizers and cleansers, and has built a successful business in connection therewith.

4. Opposer has since at least as early as August 28, 1987 used the mark “CALIFORNIA TAN” for skin care preparations and tanning products. Opposer has since at least as early as August 28, 1987 used such mark in commerce for such goods.

5. Use of the “CALIFORNIA TAN” mark by Opposer has been continuous and commercially significant. Promotional material showing Opposer’s use of “CALIFORNIA TAN” is attached as Exhibit A.

6. Opposer has taken steps to protect the “CALIFORNIA TAN” mark and has secured U.S. Trademark Registration No. 1,487,357 for such mark for the skin care and tanning preparations identified therein. Registration No. 1,487,357 is valid and subsisting and a

copy of the pertinent information about such registration from the Patent and Trademark Office database is attached as Exhibit B.

7. Opposer has since 1987 taken steps to develop a family of skincare and tanning preparations associated with the “CALIFORNIA TAN” trademark. Promotional material showing some of the products of Opposer is attached as Exhibit C.

8. Opposer’s registered trademark “CALIFORNIA TAN,” and Opposer’s family of products are inherently distinctive as applied to Opposer’s skin care and tanning preparations and business.

9. By virtue of Opposer’s continuous use in commerce of its registered “CALIFORNIA TAN” trademark and its development and use of the family of products associated with its trademark, such products and business have become favorably known to the relevant trade and public under the “CALIFORNIA TAN” trademark and name.

10. Opposer is the owner of a U.S. trademark registration for “CALIFORNIA TAN;” accordingly priority is not in issue.

11. In the Application herein opposed, there are no restrictions on trade channels, so it must be assumed that the goods identified in the Application will travel through all trade channels appropriate for goods of such type.

12. Applicant’s mark as intended to be used in connection with the goods identified in the Application is confusingly similar to Opposer’s registered “CALIFORNIA TAN” trademark and also to the family of products established by Opposer, as used in connection with Opposer’s goods and business.

13. Both of the marks have as its dominant element the identical term, “CALIFORNIA”.

14. The goods of Opposer and the goods of Applicant are for Class 003, in part, and are identical or are otherwise closely related, being cosmetics, skincare products and in particular tanning lotions.

15. Skin care products and in particular tanning lotions, such as are sold by Opposer and those identified in the Application herein opposed are customarily sold and marketed through the same and overlapping channels of trade.

16. The preparations marketed and sold under Opposer's registered "CALIFORNIA TAN" trademark and Opposer's family of products, and the preparations intended to be sold under Applicant's "CALIFORNIA GLOW" mark, are such as would be sold to the same and to overlapping classes of purchasers, namely beauty and cosmetics consumers, generally and through the same and overlapping channels of trade.

17. Applicant's "CALIFORNIA GLOW" trademark as applied to the goods set forth in the Application so resembles Opposer's "CALIFORNIA TAN" trademark, and as a result, Opposer's products and name as used in connection with Opposer's business, that it is likely to cause confusion, mistake and/or deception.

18. If Applicant is permitted to register "CALIFORNIA GLOW" for the goods set forth in the Application, confusion of the relevant trade and public is likely to result, which will damage and injure Opposer.

19. Applicant's "CALIFORNIA GLOW" mark used in connection with Applicant's goods is likely to cause purchasers and potential purchasers to believe in error that such goods are offered by or in association with or under license from Opposer, that Opposer and Applicant are affiliated, or that Opposer's goods and Applicant's goods are sold as components of a single line of health and beauty products.

20. Any defect, objection to or fault found with Applicant's goods sold under its mark "CALIFORNIA GLOW" would necessarily reflect on and seriously injure the reputation that Opposer has established for its goods and business.

21. If Applicant is granted a registration for the mark herein opposed, it would obtain thereby at least a prima facie exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer and Opposer's customers.

22. WHEREFORE, California Tan, Inc., prays that registration of the mark of Application Serial No.78/880892 be refused and that this opposition be sustained.

CALIFORNATAN[®].com

THE TANNING AUTHORITY INDOOR • OUTDOOR • SUNLESS

Simply put, we know tanning. No other company offers you so many choices when it comes to developing a healthy, natural-looking, golden-brown tan.

Founder of the Original 3-Step System, California Tan has high performance tanning products that feature exclusive technologies and advanced skincare ingredients to work with your skin to deliver a fast, dark tan - any way you want it.

INDOOR 3-STEP SYSTEM

STEP 1: BASE TAN BUILDER
STEP 2: DARK TAN BOOSTER
STEP 3: DARK TAN EXTENDER

OUTDOOR 3-STEP SYSTEM

STEP 1: BASE TAN BUILDER
STEP 2: SUN BURN PROTECTOR
STEP 3: DARK TAN EXTENDER

SUNLESS 3-STEP SYSTEM

STEP 1: PREPARE
STEP 2: DEVELOP
STEP 3: EXTEND & ENHANCE

Visit www.californiatan.com where you can win prizes, find the best product for you, learn more about tanning and California Tan products, and much, much more!

California Tan[®]
Est. 1987

Authentic Brand • Genuine Quality • 100% Guaranteed



Exhibit B

Int. Cl.: 3

Prior U.S. Cls.: 51 and 52

United States Patent and Trademark Office

Reg. No. 1,487,357
Registered May 10, 1988

TRADEMARK PRINCIPAL REGISTER

CALIFORNIA TAN

CALIFORNIA SUNCARE, INC. (CALIFORNIA
CORPORATION)
SUITE 1231
1100 GLENDON
WESTWOOD, CA 90024

MOISTURIZERS AND CLEANSERS, IN CLASS
3 (U.S. CLS. 51 AND 52),
FIRST USE 8-28-1987; IN COMMERCE
8-28-1987.

SER. NO. 687,315, FILED 10-1-1987.

FOR: SKIN CARE PRODUCTS, NAMELY,
TANNING LOTIONS, GELS AND OILS; AND

HELEN ROBERTS WENDEL, EXAMINING AT-
TORNEY

CALIFORNIA TAN



Tan! Collection

ark Tan

ip One Accelerator

ip Two Maximizer

Step One Accelerator with Double-Action Bronzers

Step Two Maximizer with Double-Action Bronzers

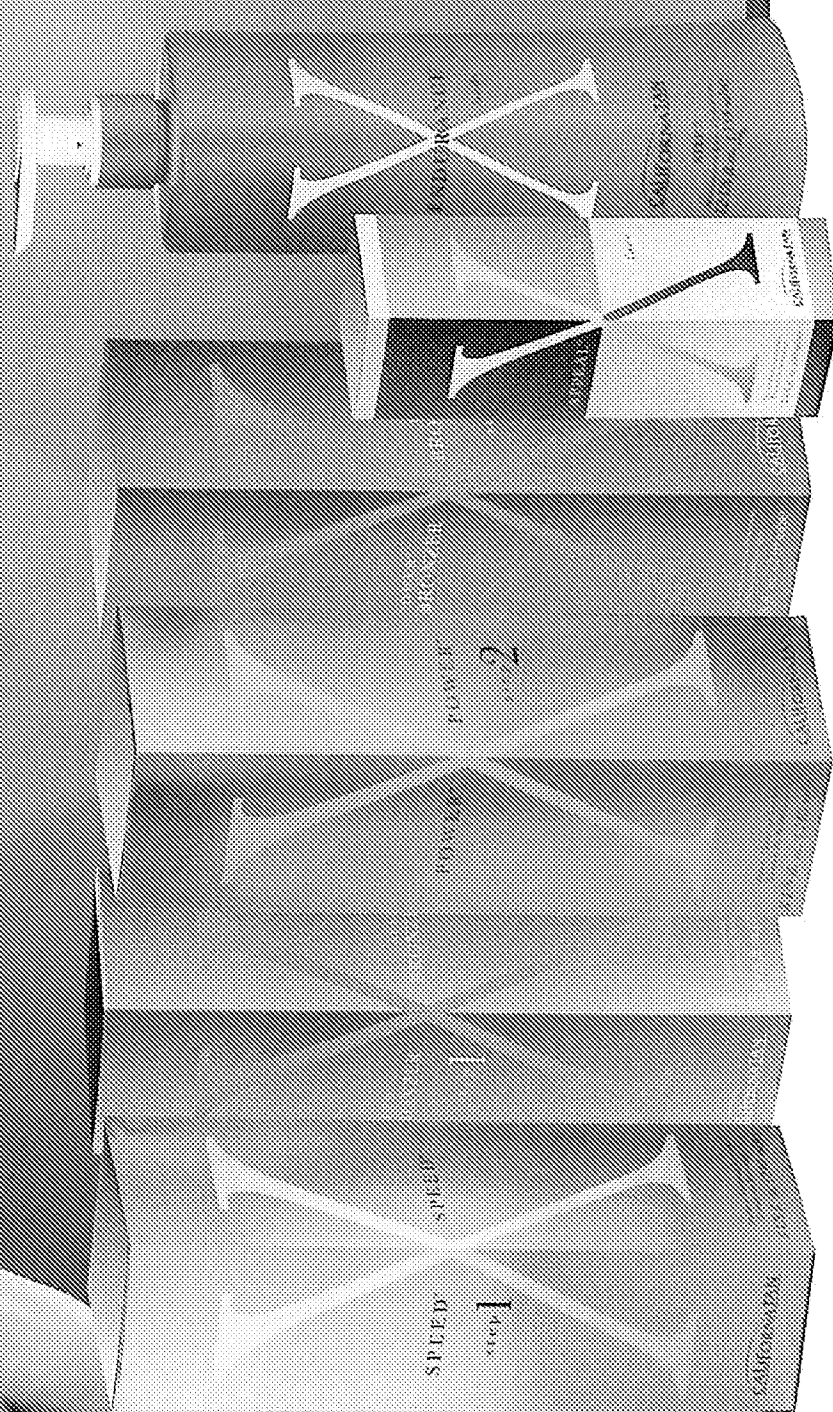
Original Collection

The Proven Approach to Developing Color

MaxLotion™ Step One Accelerator

Rage® Lotion Step Two Maximizer

CALIFORNIAIAN



X Collection

The Proven Standard for Unsung. High-Output Results

- X Speed™ Step One Accelerator
- X Speed™ Bronzer Step One Accelerator with Triple-Action Bronzers
- X Power® Step Two Maximizer
- X Power® Bronzer Step Two Maximizer with Triple-Action Bronzers
- X Endurance™ Body Step Three Tan Extender
- X Appeal™ Face Specialty with Double-Action Bronzers

X Appeal Face Clinically Tested for Superior Skincare

- 38% reduction in appearance of fine lines and wrinkles
- 40% improvement in skin firmness and suppleness
- 55% improvement in uniform skin pigmentation
- 92% improvement in moisturization